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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,546	02/15/2002	Peter A. Leeds	L9090/269380	3820
23370	7590	11/16/2006	EXAMINER	
JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET ATLANTA, GA 30309			BASIT, ABDUL	
			ART UNIT	PAPER NUMBER
			3694	

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/077,546	<b>Applicant(s)</b> LEEDS ET AL.	
	<b>Examiner</b> Abdul Basit	<b>Art Unit</b> 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2/15/2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/14/2003</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

It is noted that this application appears to claim subject matter disclosed in prior Application No. 60154667, filed 09/16/1999. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e),

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120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claim 1-8, 12-13, 15, 17, 19, and 20 rejected under 35 U.S.C. 102(a) as being anticipated by Verba et al (US Pat. No. 6,236,977).

Regarding Claim 1:

- Verba teaches an electronic commerce system that can be used in the context of a variety of businesses. (*Column 1 lines. 18-21*). Verba teaches the use of a plurality of different trading groups for that electronic commerce system. (*Column 4 lines. 9-14*).
- Verba teaches a system that allows for the listing of an asset with any of the different trading groups. (*Column 4 lines 15-35*).
- Verba teaches the ability of any of the different trading groups to view information on available assets. (*Column 4 lines 14-18*).
- Verba teaches using workflow for automating aspects of executing a contract, since the invention taught by Verba is computer implemented. (*Column 4, lines 38-60*). Workflow is defined by the Workflow Management Coalition ([www.wfmc.org](http://www.wfmc.org)) as the automation of business procedures.

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Regarding claim 2

- Verba teaches that the trading groups will have authorized users. (*Column 4 lines 38-60*)

Regarding claim 3:

- Verba teaches participation in an online exchange. (*Column 2 lines 13-22*).

Regarding claim 4:

- Verba teaches forming a business relationship between a broker and another trading group. (*Column 2 lines 25-35*).

Regarding claim 5:

- Verba teaches the ability to place an asset with any of the different trading groups. (*Column 4 generally*).

Regarding claim 6:

- Verba teaches a search capability of desired assets. (*Column 4 generally*).

Regarding claim 7:

- Verba teaches the capability to browse through categories of asset. (*Column. 2 lines 55-67*).

Regarding claim 8:

- Verba teaches the capability of searching by keyword. (*Column 2 lines 55-67*).

Regarding claim 12:

- Verba teaches using workflow for procuring assets, since the invention taught by Verba is computer implemented. (*Also see rejection for claim 1*).

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Regarding claim 13:

- Verba teaches the use of workflow to list assets. (*Column 4 lines. 14-18*).

Regarding claim 15:

- Verba teaches the ability to categorize assets with different trading groups.  
(*Column 2 lines. 55-67 and Column 3 lines 1-26*).

Regarding claim 17:

- Verba teaches the ability to manage a system that has multiple trading groups.  
(*Column 8, lines 12-33*)

Regarding claim 19:

- Verba teaches the ability of different trading groups to view details on assets.  
(*Column 4 lines. 14-18*).

Regarding claim 20:

- Verba teaches the ability to list any asset selectively or a combination of different trading groups. (*Column 4 generally*).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 9, 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Verba ('977) in view of Popola ( US Pat. 5,715,402). Claim 9 is dependant on claim 6. Claim 6, a dependent claim of claim 1, was rejected under 35 U.S.C. 102(a) as

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being anticipated by Verba. Verba does not teach a capability of tracking certain assets. However:

Regarding Claim 9:

- Popola does teach the ability of a trading group to locate items. (*Column 1 lines 63-65*).

Regarding Claim 11:

- Popola suggests the use of workflow for inspecting assets before assets are listed.

Regarding Claim 15:

- Popola does teach normalization which is taking raw data and placing it to fit a product taxonomy. (*Column 6 generally*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Verba and Popola. One of ordinary skill in the art would have been motivated to track items, since it would enhance the ability of different trading groups to find a desired product. Also, one would have been motivated to inspect items before the items are listed because this would allow for a higher quality of product thus reducing returns and future lost sales. Finally, one would have been motivated to take data and place in a systematic category system since this would create a more efficient process.

3. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Verba ('977) in view of Lawrence (US Pat. 5,915,209). Claim 10 is dependant on claim 6.

Claim 6, a dependent claim on claim 1, was rejected under 35 U.S.C. 102(a) as being



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anticipated by Verba. Verba does not teach the capability of being alerted when a desired asset becomes listed. However, Lawrence does teach the use of an alert system (*Column 8 lines 48-62*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Verba and Lawrence. One of ordinary skill in the art would have been motivated to inspect items, since this allows for more efficient trading between different trading groups.

4. Claims 14 and 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Verba ('977) in view of Luke et al (US Pat. 6,131,087). Claim 18 is dependent on claim 1. Claim 1 was rejected under 35 U.S.C. 102(a) as being anticipated by Verba. Verba does not teach the electronic commerce system with a legacy computer system.

However:

Regarding Claim 14:

- Luke does teach the use of workflow to obtain authorization within an entity.  
(*Column 11, lines 40-45*).

Regarding Claim 18:

- Luke does teach integration with a legacy system. (*Column 3 lines 47-48*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Verba and Luke. One of ordinary skill in the art would have been motivated to integrate the electronic commerce system with a legacy system since this would save the expense of implementing a new system. Further one of ordinary skill in

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the art would have been motivated to ensure that an authorization workflow existed to prevent fraud and enhance profitability.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdul Basit whose telephone number is 571 272-7246. The examiner can normally be reached on Monday - Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571 272 6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AQB

  
ELLA COLBERT  
PRIMARY EXAMINER